



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,264	09/10/1999	CYNTHIA C. MORTON	10286/008001	3961
26161	7590	09/07/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110				WINKLER, ULRIKE
		ART UNIT		PAPER NUMBER
		1648		

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/394,264	MORTON ET AL.	
	Examiner	Art Unit	
	Ulrike Winkler	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 35-69 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 35-61, 64-69 is/are allowed.
- 6) Claim(s) 62 and 63 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

The Amendment filed June 1, 2004 in response to the Office Action of May 26, is acknowledged and has been entered. Claims 1-34 have been cancelled. Claims 35-69 are pending and are currently being examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112

The rejection of claims 35-61 and 64-69 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement **is withdrawn** in view of Applicant's amendment to the claims.

The rejection of claim claims 62 and 63 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement **is maintained** for reasons of record. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claims are drawn to probes and primers that can detect a lesion in SEQ ID NO:1 or a lesion in the naturally occurring variant of SEQ ID NO:1, the disclosure fails to provide a representative number of species to describe and enable the genus as broadly claimed.

The rejection of claims 35-69 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for diagnosing a hearing loss or a condition that is predictive

of developing a hearing loss due to the specific substitution at residues 51, 66, 88 and 117 of SEQ ID NO:2, does not reasonably provide enablement for insertions or deletion at one or more nucleotides encoding the specific amino acids is **withdrawn** in view of Applicant's amendments.

Minor formalities:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Specifically Applicant should avoid using "novel" in the title, a patent is presumed novel. For example the title could read as follows:

"Probes to detect lesions associated with hearing loss in the cochlear gene COCH5B2."

Conclusion

Claims 35-61 and 64-69 are allowable.

Claims 62 and 63 are rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baker et al. US 2002/0127584 A1 this is the national stage application of the previously cited Wood et al. WO 99/14328.

The application US 2002/0127584 A1 (see specifically SEQ ID NO: 227 and 228) is drawn to nucleic acids and their encoded polypeptides, as well as uses of the nucleic acid see paragraphs 0761-0778 as primers and probes. Once the referenced application issues into a patent it may be cited as prior art under 35 USC 102(e) with a priority claim that goes back to 1997.

Applicant is advised that the instantly allowable claims are drawn to potentially interfering subject matter with application US 2002/0127584 A1. Limiting the claims to probes that have a defined length and preferably citing specific SEQ NOs wherein the probes span the regions of SEQ ID NO:1 that are associated with the hearing loss could avoid the potential interference with application US 2002/0127584 A1.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989). The Group 1600 Official Fax number is: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center representative whose telephone number is (571)-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 571-272-0912. The examiner can normally be reached M-F, 8:30 am - 5 pm. The examiner can also be reached via email [ulrike.winkler@uspto.gov].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 571-272-0902.


ULRIKE WINKLER, PH.D.
PRIMARY EXAMINER
9/1/04